

Kennedy, Ronald G.

S/N: 09/474,418

**REMARKS**

Claims 1-24 are pending in the present application. In the Office Action mailed May 20, 2004, the Examiner withdrew all previous rejections. Applicant appreciates the indication of distinction of the present claims over all previously applied references. The Examiner has now rejected claims 1-24 under 35 U.S.C. §103(a) as being unpatentable over Slayton (USP 6,440,071) in view of Wood et al. (USP 5,715,823). Additionally, claims 1-24 are provisionally rejected under the judicially created doctrine of double patenting over claims 1-44 of Application No. 09/199,506.

**Rejection Under §103(a)**

The Examiner rejected claims 1-24 as unpatentable over Slayton et al. in view of Wood et al. The burden of establishing a *prima facie* case of obviousness falls on the Examiner. MPEP §2142. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). Accordingly, to establish a *prima facie* case, the Examiner must not only show that the combination includes each and every element of the claimed invention, but also provide "a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). That is, "[o]bviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art." MPEP § 2143.01.

Furthermore, "[t]he fact that references can be combined or modified is not sufficient to establish *prima facie* obviousness." *Id.* For example, "[i]f the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious." MPEP §2143 citing *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

In the case at hand, the Examiner impermissibly combine Slayton et al. and Wood et al. Specifically, the references are directed to very different systems that cannot be combined

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without (1) using impermissible hindsight and (2) changing the principle of operation of the references.

The Examiner acknowledged that "Slayton does not explicitly disclose a least one on-line center having access to service software at a centralized facility so as to service in-field product remotely." As such, to overcome this deficiency of the rejection, the Examiner proposed the modification of Slayton et al. with the system of Wood et al. However, the Examiner failed to provide the requisite convincing line of reasoning to establish why one of ordinary skill in the art would have found the claimed invention obvious in light of the teachings of the references. Rather, the Examiner summarily concluded that one would have been motivated "for the purpose of enabling ultrasound systems to be accessed through an open architecture communications network."

However, as clearly stated on page 10 of the current Patent Application, the current invention "permit[s] data to be transferred to and from the systems over an open network, such as the Internet as well." Therefore, the Examiner's basis for the combination is based, at least in part, on Applicant's own disclosure, not the prior art, which is clearly impermissible under MPEP §2143.

Furthermore, the combination proposed by the Examiner would change the principle of operation of the references. Specifically, Slayton et al. is explicitly directed to "a peripheral ultrasound imaging system capable of connection to a personal computing device or a computer network that enables a user to perform real time ultrasound imaging without the need for a plurality of modules typically needed for ultrasound imaging, such as, for example, scanning modules, display modules and converter modules, and without the need to modify, augment or replace the central processing unit of the personal computing device or computer network." Col. 1, Ins. 7-15. Therefore, Slayton et al. is specifically directed to a system incorporating a peripheral ultrasound device in combination with a computer so as to avoid traditional proprietary ultrasound systems. Simply, Slayton et al. teaches the use of a personal computer to replace a traditional "all-in-one" ultrasound device.

On the other hand, Wood et al. teaches the use of the traditional dedicated or "all-in-one" ultrasound systems which are specifically designed to allow network communication "with no special hardware requirement." See Abstract and Figs. 15-17. As such, the principles of operation of Slayton et al. and Wood et al. would be impaired if combined in the manner proposed by the Examiner because one teaches the use of traditional dedicated ultrasound system that are capable

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of network communications without any special hardware requirements while the other requires the use of a personal computer instead of a traditional dedicated ultrasound system.

Simply, the combination of Slayton et al. and Wood et al. requires that the traditional "all-in-one" ultrasound system of Wood et al. replace the peripheral/personal computer ultrasound system of Slayton et al. or vice versa. In either case, such a modification would clearly frustrate the express purpose of either Slayton et al. or Wood et al. Accordingly, the combination proposed by the Examiner is impermissible under MPEP §2143.

#### **Removal of Slayton et al.**

The above points illustrate just a few of the reasons why the current rejection is improper and unsustainable. However, in an effort to expedite allowance of the current application, which has been pending since December 12, 1999, Applicant also hereby antedates Slayton et al. Accordingly, enclosed herewith is a Declaration under 37 C.F.R. 1.131 together with a three-page attachment labeled Exhibit A. Applicant asserts an invention date prior to the effective date of Slayton et al. The enclosed Declaration, which evidences a date of conception prior to the effective date of the Slayton et al. reference, together with due diligence to an actual reduction to practice, is sufficient to eliminate Slayton et al. as prior art. Withdrawal of the Examiner's rejections is requested and appreciated.

#### **Provisional Double Patenting**

Applicant notes that the Examiner provisionally rejected claims 1-24 under the judicially created doctrine of double patenting over claims 1-44 of Application No. 09/199,506. However, due to the provisional nature of the rejection, Applicant is not in a position to provide remarks with respect to the provisional rejection. MPEP §804(I)(B) states that "[i]f the 'provisional' double patenting rejection in one application is the only rejection remaining in that application, the examiner should then withdraw that rejection and permit the application to issue as a patent." Therefore, since all other rejections have been overcome, Applicant requests withdrawal of the provisional double patenting rejection and a timely issuance of a Notice of Allowance.

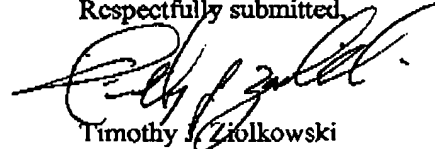
Therefore, in light of the foregoing, Applicant respectfully believes that the present application is in condition for allowance. As a result, Applicant respectfully requests timely issuance of a Notice of Allowance for claims 1-24.

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Applicant appreciates the Examiner's consideration of these Remarks and cordially invites the Examiner to call the undersigned, should the Examiner consider any matters unresolved or require further explanation if the same would further prosecution of this case.

Respectfully submitted,



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